

REMARKS

Claims 61, 68, and 81, 82, 87-90, and 100-102 are pending. Claims 61 and 68 are allowed per the Office Action mailed August 28, 2006. Claims 61, 68, 81, 87, 89, 100, and 101 are amended. New claim 102 is added. Claims 83 and 84 are cancelled herein without prejudice. Cancellation of the claims is without waiver of Applicants' right to pursue the cancelled subject matter of these claims in one or more continuation or divisional applications. No new matter is added as a result of the amendments or new claim.

Support for new claim 102 can be found at least at page 6 of the specification, lines 21-24, which states that “[i]n another embodiment the kit for detecting FD mutations will also contain genetic tests for diagnosing additional genetic diseases, such as Canavan's disease, Tay-Sachs disease, Goucher disease, cystic fibrosis, Fanconi anemia, and Bloom syndrome.”

Claim Objections

Claim 101 is objected to because the Examiner states that the claim refers back to the oligonucleotide probe of claim 100, whereas claim 100 is drawn to a kit comprising an oligonucleotide probe. As per the Examiner's suggestion, Applicants have amended claim 101 to refer to the “kit of claim 100.” Applicants therefore respectfully request removal of the objection.

Claim Rejections35 U.S.C. §112, second paragraph

Claims 81-84, 87-90, 100, and 101 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that the claims are indefinite over the recitation of “the

FD” mutation because “the phrase lacks proper antecedent basis since the claims do not previously refer to a FD mutation.” As the Examiner has suggested, Applicants have amended claims 81-84 and 87-90 to recite “a FD1 mutation at position 34,201 of SEQ ID NO:1” and “a FD2 mutation at position 33,714 of SEQ ID NO:1,” and have amended claim 100 to provide antecedent basis in the preamble. Applicants submit that these amendments do not change the scope of the claims.

The Examiner also states that, although the instant specification defines both “FD1 mutation” and “FD2 mutation” it is recommended to amend allowed claims 61 and 68 to include the definitions of these terms. Applicants therefore have amended claim 61 to recite “a FD1 mutation at position 34,201 of SEQ ID NO:1” and “a FD2 mutation at position 33,714 of SEQ ID NO:1.”

The Examiner further states that claims 87-90, 100, and 101 are indefinite over the recitation of “nucleotide corresponding to” is “not an art recognized term to describe the relationship between a nucleotide and a nucleic acid sequence.” In order to clarify the meaning of “the nucleotide corresponding to” the specific positions recited, Applicants have amended the claims to recite “the nucleotide which is at the same position as position 34,201 of SEQ ID NO:1” and “the nucleotide which is at the same position as position 33,714 of SEQ ID NO:1.” Applicants submit that these amendments do not change the scope of the claims.

35 U.S.C. §§102(b) and 103(a)

Claims 83 and 100 are rejected under 35 U.S.C. §102(b) as being anticipated by Cohen (U.S. Patent No. 5,891,719) and claims 84 and 101 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen. The Examiner states that Cohen discloses oligonucleotides of the

IKAP gene which include nucleotide 33,714 of SEQ ID NO: 1 of the instant application. In order to advance prosecution, Applicants have cancelled claims 83 and 84. Regarding claims 100 and 101, claim 100 has been amended to recite "A kit for the detection of the FD1 and FD2 mutations," so that the claim now requires that oligonucleotide probes for both the FD1 mutation and the FD2 mutation are within the kit. As the Examiner has recognized that the oligonucleotides recited in claims 81 and 87 for detecting the FD1 mutation are patentable over Cohen, Applicants submit that Cohen does not disclose the combination of oligonucleotides for detecting FD1 and FD2 mutations, and therefore, does not anticipate or render obvious the claimed kits. Applicants therefore respectfully request that the rejections under 35 U.S.C. §§102(b) and 103(a) be withdrawn.

CONCLUSION

Based on the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 50-3732, Order No. 13572.105039.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a

petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 50-3732, Order No. 13572.105039.

Respectfully submitted,
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